

REMARKS

Reconsideration and allowance of this application, as amended, is respectfully requested.

This Amendment is in response to the Office Action dated June 3, 2004. By the present Amendment, claims 8 and 10 have been amended for clarification and new claim 16 and 17 have been added to further define the invention.

Briefly, the present claimed invention pertains to a base station designed for improving communications with communication terminals, for example, portable communication terminals. Referring to Fig. 1 (solely for purposes of example), base station such as 103A and 103B are shown communicating with portable communication terminals 104A-C and 104D-F, respectively. Figs. 8 and 11 show examples of embodiments of such base stations in accordance with the claimed invention (again referring to these figures solely for purposes of example). As shown in Fig. 8, the base station includes an advertising information data base 174, a distribution history data base 175, a main program 173, an advertising information selection screen file 176, and a radio section 172, all controlled by a controller 170. the controller 170 is coupled, in turn, to an I/O controller 171 to permit coupling to a network 100 for input and output. This base station arrangement permits improved communication with the communication terminals to provide the desired advertising information to a user.

Reconsideration and removal of the 35 U.S.C. § 103 rejection of independent claim 7 as being unpatentable over Leapman (US 2002/0087401) in view Hendry (USP 6647269) is respectfully requested. Independent claim 7 specifically defines the structure of a base station including a storing section for storing advertising

information, a radio communication system for transmitting and receiving data from portable communication terminals (such as 104A-F in Fig. 1) and a finder device for finding at least one of the portable communication terminals. In addition, the last paragraph of claim 7 particularly defines:

1. that the base station transmits a radio connection request to the found portable communication terminal; and
2. when the connection approval is received from the portable communication terminal, the base station transmits both information for selection of advertisement information to the portable connection terminal and also transmits the selected advertisement information to the portable communication terminal.

It is respectfully submitted that Leapman fails to teach or suggest these features, whether considered alone or in combination with Hendry.

More specifically, although Leapman may initially appear to have similar structure as that defined by claim 7, in fact, the arrangement in Leapman operates in a completely different manner from that defined by claim 7 (particularly with regard to the last paragraph of claim 7). For example, as discussed in the abstract of Leapman, the purpose of the Leapman reference is to provide broadcast information that is filtered by the communication device. For this purpose, a mobile device 100 stores acceptance data which is used to be compared with advertising data received from the advertising broadcast system 102. The result of this comparison determines whether the advertising data from the advertisement broadcasting system 102 should be accepted or rejected, thereby providing the desired filter. However, there is no suggestion or disclosure in Leapman regarding the limitation

set forth in claim 7 that "the base station transmits information for selection of advertisement information to the portable communication terminal." In addition, nothing in Hendry provides any teaching or suggestion to make up for this fundamental shortcoming in Leapman with regard to meeting the limitations of claim 7. Accordingly, reconsideration and allowance of independent claim 7 over the combination of Leapman and Hendry is respectfully requested.

Reconsideration and allowance of dependent claim 8 over Leapman is also respectfully requested. Claim 8 is directed to the feature of the present invention that a user can select either a simplified version of the advertisement information or a more detail version thereof. To this end, claim 8 has been amended to specifically define:

"wherein said second advertisement information comprises a more detailed version of said first advertisement information with respect to each advertisement object."

As such, it is respectfully submitted that this serves to even further define over the combination of Leapman and Hendry, which completely lack any such teaching.

In the Office Action, the features of claim 8 have been "given no patentable weight" since it is stated that these features are claimed in terms in function rather than structure. In response to this, claim 8 has been amended to particularly define the recited features in means plus function format. Accordingly, these features must now be given complete consideration and patentable weight in light of the approval of the means plus function format in 35 U.S.C. § 112, sixth paragraph. Therefore, such consideration, together with the allowance of claim 8 is respectfully requested, inasmuch as the features defined by claim 8 concerning the first and second

advertisement information are neither taught nor suggested by the cited references to Leapman or Hendry, whether considered alone or in combination with one another.

Reconsideration of dependent claim 9 over the combination of Leapman and Hendry is also respectfully requested. Claim 9 defines the features of the invention of means for permitting a remote server connected via a network to update advertisement information in the base station. Like claim 8, claim 9 has been amended to define these features in a means plus function format. Thus, claim 9 clearly sets forth means for adding or deleting advertisement information with respect to the storage section for storing advertisement information according to instruction information received from a server system via the network, and means for updating information to select the advertisement information. It is respectfully submitted that the cited prior art completely fails to teach or suggest such features.

In the Office Action, regarding claim 9, it is stated that:

“providing a computer obviously indicates ability to record or delete files.”

As such, it is Applicants understanding that the Examiner recognizes that the prior art fails to teach or suggest these claimed features, and it relying, instead, on common knowledge concerning the operation of computers. In response, Applicants respectfully point out that claim 9 calls for more than simply recording or deleting files. On the contrary, claim 9 specifically defines the nature of the files in terms of “advertisement information with respect to said storage section for storing advertisement information according to instruction information received from a server

system via the network.” In conjunction with this, claim 9 defines means for updating information to select the advertisement information. Therefore, specific recitations are provided in claim 9 which go well beyond the general statements made in the Office Action.

With regard to the use of common knowledge in the art, MPEP 2144.03 clearly sets forth that the use of such reliance “should be rare, and, further:

“should only be taken by the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known.”

This follows in line with the requirements of the CAFC decision of In re Lee, 61 USPQ 2d (Fed. Cir. 2002) which states:

“The factual question of motivation is material to patentability, and could not be resolved on subject belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been lead to this combination of references, simply to “use that which the inventor taught against its teacher.”

In addition, it is noted that the rejection of claim 9 specifically relies on the “ability to record or delete files” of a computer. It is respectfully submitted that this falls within the “obvious to try” rationale which was specifically prohibited by the CCPA in the case of In re Antonie, 195 USPQ 6 (CCPA 1977) and by the CAFC in the case of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988). As noted by the CCPA in the In re Antonie case:

“The PTO and the minority appear to argue that it would always be obvious for one of ordinary in the art to try varying every parameter of the system in order to optimize the effectiveness of the system even if there is no evidence in the record that the prior art recognized that particular parameter affected the result. As we have said many times, obvious to try is not the standard of 35 U.S.C. § 103.” 195 USPQ at 8

In the present instance, it is respectfully submitted that the rejection based on the ability of a computer to record or delete files falls within this same general heading of it being "obvious to try" using the computer to meet the detailed limitations of claim 9. Accordingly, for the reasons set forth above, reconsideration and allowance of dependent claim 9 is respectfully requested.

Reconsideration and allowance of new dependent claim 16, which depends on claim 9, is also respectfully requested. This new dependent claim further defines claim 9 by defining the updating of information pertains to advertising information selection screen information. This is completely unsuggested by the cited prior art to Leapman and Hendry. Therefore, allowance of this newly submitted dependent claim is respectfully requested.

Reconsideration and allowance of dependent claims 10 and 11 is also respectfully requested. Claim 10 is directed to the feature of the base station storing an identifier of a found portable communication terminal. Claim 11 is directed to the further feature of transmitting found portable-communication-terminal history to a server system connected to the network. Nothing in either Leapman or Hendry teaches or suggests these features, particularly when considered in combination with the features of the parent claim 7. Therefore, reconsideration and allowance of dependent claim 10 and 11 is also respectfully requested.

Finally, reconsideration and allowance of newly presented independent claim 17 is respectfully requested. Claim 17 contains the features of claim 7, specifically defined in a means plus function format. As such, claim 17 includes the feature of means for transmitting information for selection of advertisement information from the base station to the portable communication terminal when a connection approval

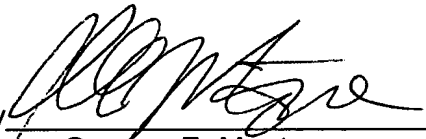
has been received from the portable communication terminal. As discussed above regarding claim 7, this feature is completely lacking from either Leapman or Hendry and particularly when considered within the overall combination defined by both claims 7 and 17. Therefore, reconsideration and allowance of newly presented independent claim 17 is also respectfully requested.

If the Examiner believes that there are any other points which may be clarified or otherwise disposed of either by telephone discussion or by personal interview, the Examiner is invited to contact Applicants' undersigned attorney at the number indicated below.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Antonelli, Terry, Stout & Kraus, LLP Deposit Account No. 01-2135 (Docket No. 500.40529X00), and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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